UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,074	02/02/2004	Jennifer Hay	M93.12-0296	9839

27367	7590	08/28/2006

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EXAMINER
LE, TOAN M

ART UNIT	PAPER NUMBER
2863	

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/770,074	HAY, JENNIFER
	Examiner	Art Unit	
	Toan M. Le	2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*06 June 2006*</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
  closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5-38,40-46,48 and 49* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5-38,40-46,48 and 49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 June 2006* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
  application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 5-38, 40-46, and 48-49 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. The method claims do not produce a

tangible result. It is unclear how the result is being stored, displayed, or used in any tangible

manner. In order to overcome the rejection, claim language should be added that includes

displaying, storing or conveying used in tangible manner. To view the new guidelines for 35

U.S.C. 101 please view the following OG notice.

http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by "Instrumented

Indentation Testing", Hay et al. (referred hereafter hay et al.).

Referring to claims 20-22, Hay et al. disclose a computer readable medium including

instructions readable by a computer, which when implemented, cause the computer to detect an

initial point of engagement between an indenter or tensile tester and a test sample from data

measurements comprising the steps of:

receiving a data series indicative of test measurements as a function of a first variable;

generating at least one processed series from the data series (page 232, 3rd col. to page 233, 1st and 2nd col.; page 236, Measurement of Creep Parameters section: 1st col.);

identifying a first point on the at least one processed series;

identifying a second point on the at least one processed series (figures 4 and 9);

calculating the initial point of engagement as a function of the first point, the second point, and the speed of the indenter or tensile tester relative to the sample; and further comprising receiving the data series as a function of at least one other variable and wherein the test measurements indicate force (page 233, 2nd and 3rd col.; page 236, Measurement of Creep Parameters section).

As to claim 23, Hay et al. disclose a computer readable medium including instructions readable by a computer, which when implemented, cause the computer to detect a point of engagement between an indenter or tensile test system and a test sample comprising the steps of:

receiving a data series indicative of test measurements as a function of a first variable;

generating at least one processed series from the data series (page 232, 3rd col. to page 233, 1st and 2nd col.; page 236, Measurement of Creep Parameters section: 1st col.);

identifying a first point on the at least one processed series;

identifying a second point on the at least one processed series (figures 4 and 9);

calculating the point of engagement as a function of at least one of the first point and the second point (figures 4 and 9);

receiving the data series as a function of at least one other variables, wherein the test measurements indicate force, and wherein the first variable comprises displacement and the at

least one other variable comprises time (page 233, 2nd and 3rd col.; page 235, Time-Dependent

materials and Properties section to page 236, Measurement of Creep Parameters section).

Referring to claim 24, Hay et al. disclose a computer readable medium including

instructions readable by a computer, which when implemented, cause the computer to detect an

initial point of engagement between an indenter or tensile tester and a test sample from data

measurements comprising the steps of:

receiving a data series indicative of test measurements as a function of a first variable;

generating at least one processed series from the data series (page 232, 3rd col. to page

233, 1st and 2nd col.; page 236, Measurement of Creep Parameters section: 1st col.);

identifying a first point on the at least one processed series;

identifying a second point on the at least one processed series (figures 4 and 9);

calculating the initial point of engagement as a function of both the first point and the

second point (figures 4 and 9); and

receiving the data series as a function of at least one other variable, wherein generating at

least one processed series comprises calculating speed of the indenter or tensile tester relative to

the test sample to generate a first processed series (page 233, 2nd and 3rd col.; page 235, Time-

Dependent materials and Properties section to page 236, Measurement of Creep Parameters

section).

Response to Arguments

Applicant's arguments with respect to claims 1-2, 5-38, 40-46, and 48-49 have been

considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Toan M. Le whose telephone number is (571) 272-2276. The

examiner can normally be reached on Monday through Friday from 9:00 A.M. to 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Barlow can be reached on (571) 272-2269. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Toan Le

August 18, 2006

**BRYAN BUI
PRIMARY EXAMINER**